

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 23 has also been amended for clarification purposes by deleting the objected-to term "non-foamed", and to recite that the modified stable polyisocyanates are not a foam. Support for the above amendments can be found in the instant specification at least at page 3, lines 26-33. Claim 23 has also been amended for readability purposes and now recites the term "formula (I)". Claim 24 has been amended for readability purposes by adding a comma after "-A'-'". Claim 50 has been amended in a manner consistent with the above amendment to claim 23 in which the term "non-foamed" has been deleted. Entry of the foregoing amendments is proper at least because they are effective to place the application either in condition for allowance or in better form for appeal. See M.P.E.P. §714.12.

In the Official Action, claims 23-35 and 37-59 stand rejected under 35 U.S.C. §112, first and second paragraphs, for the reasons set forth at pages 2-3 of the Official Action. These rejections are moot in light of the above amendments of claims 23 and 50 in which the objected-to term "non-foamed" has been deleted from such claims.

Claim 23 now recites that the modified stable polyisocyanates are not a foam. It is noted that the Examiner had previously taken the position that the term "foam" does not pertain to monomeric polyisocyanate reactants. Official Action at page 2. The claimed modified stable polyisocyanates, however, are not mere polyisocyanate monomers. Rather, they are modified stable polyisocyanates having the chemical structure shown in formula (I) recited in claim 23.

In view of the above, the claims are in full compliance with the provisions of the first and second paragraphs of 35 U.S.C. §112. Accordingly, withdrawal of the above rejections is respectfully requested.

Claims 23-27, 30, 31, 33-35, 42, 45, 48, 50, 55, 56 and 59 stand rejected under 35 U.S.C. §102(b) as being anticipated by European Patent Document No. 0 419 114 (*EP '114*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

EP '114 relates to a method for the preparation of polymeric foams which comprises reacting an organic polyisocyanate with a cyclic carbonate having at least one isocyanate-reactive substituent attached to the carbonate ring. This document is discussed at page 3 of the present specification.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

EP '114 does not disclose each feature recited in independent claim 23, and as such fails to constitute an anticipation of such claim. For example, *EP '114* does not disclose modified stable polyisocyanates of formula (I) in which Iso is a polyisocyanate residue containing at least two isocyanate functions after conversion of at least one isocyanate function, as recited in claim 23. In the claimed modified stable polyisocyanates, at least two isocyanate functions remain in the "Iso" polyisocyanate residue after conversion of at least one isocyanate function. *EP '114* does not disclose such feature.

By comparison, *EP '114* discloses the use of an organic polyisocyanate, and provides a listing of compounds at page 2, line 53 to page 3, line 3, which listing sets forth various

diisocyanate compounds. *EP '114* discloses that the organic polyisocyanate is reacted with a cyclic carbonate having at least one isocyanate-reactive substituent attached to the carbonate ring, to obtain a polymeric foam product. Page 2, lines 23-25. Since the isocyanate function(s) of *EP '114*'s organic polyisocyanate react with the isocyanate-reactive substituent of the cyclic carbonate, the resulting polymeric foam would be expected to contain less than two isocyanate functions. There is simply no disclosure, either express or inherent, that the polymeric foam product disclosed by *EP '114* has a polyisocyanate residue containing at least two isocyanate functions, as is presently claimed.

Furthermore, as discussed above, the recited modified stable polyisocyanates have the formula (I) shown in claim 23, and are not a foam. *EP '114* fails to provide any disclosure of modified stable polyisocyanates having such claimed features. Concerning *EP '114*'s disclosure of a polymeric foam product, the Examiner has asserted the following at page 3 of the Official Action:

In response, while the reference does pertain to a polymeric foam product, applicant has not established that the reference does not disclose non-foamed polyisocyanate monomers that correspond to those claimed, since reactants equivalent to those of applicant are being used within the reference.

Contrary to the Examiner's assertion, however, the reactants disclosed by *EP '114*, i.e., the organic polyisocyanates described at the paragraph bridging pages 2 and 3, are not the equivalent of the claimed modified stable polyisocyanates of formula (I). Unlike the claimed modified stable polyisocyanates, the organic polyisocyanate reactants of *EP '114* do not have structure corresponding to the cyclic carbonate structure present in formula (I) of claim 23. This is apparent in view of the fact that the organic polyisocyanate reactants of *EP '114* have not yet undergone a reaction with the cyclic carbonates.

It is further submitted that *EP 114*'s polymeric foam product formed from the reaction between the organic polyisocyanate reactants and cyclic carbonates, is not the same as the

claimed modified stable polyisocyanates. As discussed above, while the claimed modified stable polyisocyanates have a formula containing a cyclic carbonate structure, such claimed polyisocyanates are not a foam. In stark contrast, *EP '114* discloses that the product formed from the reaction between the organic polyisocyanate reactant and cyclic carbonate is a polymeric foam.

Thus, neither the organic polyisocyanate reactants of *EP '114*, nor the polymeric foam product produced from such reactants, are the same as the claimed modified stable polyisocyanates of formula (I). It is therefore apparent that *EP '114* fails to constitute an anticipation of independent claim 23. Accordingly, for at least the above reasons, withdrawal of the above rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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